

REMARKS/ARGUMENTS

Claims 41-58 and 63 were previously pending in this application. Claims 41-58 and 63 stand rejected in a non-final Office Action under 35 U.S.C. § 112, first paragraph. According to the Office Action, prosecution has been reopened in view of the applicant's appeal brief filed on July 9, 2004. In response to the above-identified Office Action, Applicant respectfully seeks reconsideration of the application in view of the remarks set forth below.

A. Rejection Under 35 U.S.C. §112, First Paragraph Based on 2 Limitations in Claim 41

Claims 41-58 and 63 of this application correspond to claims of U.S. Patent No. 5,729,603. Within the Office Action, it is stated that:

The examiner does not consider this claim [Claim 41] to be directed to the same invention as that of U.S. Patent No. 5,729,603 because the support for the copied claims is not the same as that of U.S. Patent No. 5,729,603. Accordingly, an interference cannot be initiated based upon this claim.

Only two specific issues are raised whether there is adequate support for two separate limitations found in Claim 41. These limitations are reviewed separately.

1. First claim limitation at issue

In Claim 41, a limitation reads “. . . a switch matrix, settable to any of a plurality of switch configurations. . .” Within the Office Action, it is stated:

U.S. Patent No. 5,729,603 discloses that the plurality of switch configuration yields twenty-four possible combinations. However, the polarity of the signal lines is not important, thus reducing the twenty-four possibilities to 6 possible configurations as disclosed at column 4, line 32 through column 5, line 24 and exhibited in table 1. Conversely applicant's specification does not disclose the number of possible configuration, thus the support for the claimed limitation is different.

The applicant respectfully traverses and submits that such a reading of “plurality” in Claim 41 as proposed in the Office Action does not follow the guidance provided in MPEP 2301.01 Preliminaries to an Interference nor case law precedent. MPEP 2301.01 states that a claim should be given the broadest interpretation which it reasonably will support. Further, MPEP 2301.01 states in part:

In determining whether an interference is necessary, a claim should be given the broadest interpretation which it reasonably will support, bearing in mind the following general principles:

- (A) The interpretation should not be strained;
- (B) Express limitations in the claim should not be ignored nor should limitations be read therein;
- ...
- (D) A claim copied from a patent, if ambiguous, should be interpreted in the light of the patent in which it originated for purposes of determining whether a party has a right to copy a claim;
- ...

The broadest interpretation of “plurality” which claim 41 reasonably supports lies in the ordinary meaning of “plurality”, which is “more than one” or “at least two”. York Prods., Inc. v. Cent. Tractor Farm & Family Ctr., 99 F.3d 1568, 1575 (Fed. Cir. 1996)(“The term means, simply, ‘the state of being plural.’”). It is well-settled that the terms in appealed claims must be given their ordinary meaning unless another meaning is intended by the inventors. In re Morris, 127 F.3d 1048, 1055-56, 44 USPQ2d 1023, 1029. “Without an express intent to impart a novel meaning to claim terms, an inventor’s claim terms take on their ordinary meaning.” York Prods., 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996). In this case, there is no express intent to impart a novel meaning to the term “plurality” in the cited limitation. Hence, the broadest interpretation of the limitation of “a switch matrix, settable to any of a plurality of switch configurations” which claim 41 reasonably supports is that of a switch matrix, settable to any of more than one switch configurations.

Furthermore, there is no ambiguity in the limitation of “a switch matrix, settable to any of a plurality of switch configurations”, and in particular, there is no ambiguity in the phrase “a plurality of switch configurations.” As stated in MPEP 2303.01(D), **an ambiguity must exist before** one can interpret a claim copied from a patent in light of the patent in which it originated for purposes of determining whether a party has a right to copy the claim. Thus, the interpretation in light of the originating patent cannot be applied unless there is ambiguity. This principle is echoed in In re Spina, 975 F.2d 854 (Fed. Cir. 1992), which states in part:

When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it

was copied. DeGeorge v. Bernier, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed. Cir. 1985) (if claim language is ambiguous “resort must be had to the specification of the patent from which the copied claim came”).

Spina, 975 F.2d at 856. No ambiguity exists in the limitation of “a switch matrix, settable to any of a plurality of switch configurations,” and therefore it is incorrect to resort to the specification of U.S. Patent No. 5,729,603 for claim interpretation.¹

Also, as stated in MPEP 2303.01(A) and (B), claim interpretation should not be strained; express limitations in the claim should not be ignored nor should limitations be read therein. Within the Office Action, it is stated that the “plurality of switch configurations yields twenty-four possible combinations” and since the polarity of the signal lines is not important, the twenty-four possibilities can be reduced to 6 switch configurations based on the specification of U.S. Patent No. 5,729,603. However, such a reading of a “plurality of switch configurations” in claim 41 to mean “6 switch configurations” expressly contradicts the teachings of MPEP 2303.01(B) to avoid reading limitations into a claim.

It is well-settled that “when a claim is copied from another patent for interference purposes, it must be supported by the specification of the copier. . . it becomes irrelevant whether the specific text of the claim was copied from the interfering patent.” Cultor Corp. v. A.E. Staley Manufacturing Co., 224 F.3d 1328, 1332 (Fed. Cir. 2000). Also, in determining whether a copier of a patentee’s patent has a right to make a claim corresponding to a count for interference purposes, **the only inquiry is whether a copier’s disclosure contains**, in accordance with the principles of patent law, **support for material limitations of the claim** as presented in the patentee’s patent. Martin v. Mayer, 823 F.2d 500, 504 (Fed. Cir. 1987)(emphasis added)(superseded on other grounds as explained in Kubota v. Shibuya, 999 F.2d 517, 521 (Fed. Cir. 1993)). As stated in Martin:

¹ In Parins et al v. Slater, a case of **nonbinding precedence**, In re Spina is further illuminated by the Board of Patent Appeals and Interferences. “Resort to a specification from which a claim on which the count is based or resort to extrinsic evidence is only appropriate or necessary when an ambiguity exists in the count. If an ambiguity is found, resort may be had to the specification of the patent from which the claims originate to resolve the ambiguity. **See In Re Spina**, 975 F.2d 854, 856, 24 USPQ2d 1142, 1144 (Fed. Cir. 1992).” (Parins et al v. Slater, Interference No. 104,190, paper no. 81, page 6, first paragraph)(Bd. Pat. App. & Int. 2000) (citation in original).

It is not required that the application describe the claim limitations in greater detail than the invention warrants. The description must be sufficiently clear that persons of skill in the art will recognize that the applicant made the invention having those limitations. In re Wertheim, 541 F.2d 257, 262, 191 USPQ 90, 96 (CCPA 1976). Mayer's [the copier's] specification must "convey clearly to those skilled in the art to whom it is addressed ... the information that [he] has invented the specific subject matter later claimed."

823 F.2d at 505, quoting In re Ruschig, 379 F.2d 990, 995-96, 154 USPQ 118, 123 (CCPA 1967).

Furthermore, it is well settled that the claimed invention does not have to be expressed in *ipsis verbis* ["in the same words"] for the written description requirement of 35 U.S.C. § 112, first paragraph to be satisfied. See Martin v. Johnson, 59 CCPA 769, 774, 454 F.2d 746, 751 (1972)("The description need not be in *ipsis verbis* to be sufficient")(citation omitted). The claimed invention may be implicit from the original specification that the inventor had possession of the claimed subject matter at the time of the filing of the application. An explicit, verbatim description is not required under 35 U.S.C. § 112, first paragraph.

In this case, the applicant respectfully submits that the applicant's (copier's) specification supports the limitation of "a switch matrix, settable to any of a plurality of switch configurations" found in claim 41. A switch array is shown in Figs. 4, 8 and 9 of the disclosure, having four input ports which are coupled to a four line telephone base jack. (page 13, lines 13-15). The switch array 2 is manipulated by sequentially coupling pairs of line input ports until a CO dialtone is sensed by the digital MCU 100 in the receive channel. (page 13, lines 19-27). The applicant's application states that:

The digital MCU 100 is able to address and manipulate the 32 bit addressable latch 1, thereby controlling the 4x4 crosspoint switch array 2 and 100 ohm resistor shunt array 3, within the analog integrated circuit 200. The crosspoint switch array 2 has four input ports which are directly coupled to a four line telephone base unit jack 202 through the array 3, as illustrated by the lines 1-4. The 100 ohm resistor shunt array 3 contains six switchable shunt resistors, is configured in parallel with the crosspoint switch array 2 input ports, and is capable of providing a 100 ohm shunt resistance between any of the 4 line inputs.

When a telephone accessory including the interface system of the present invention is first plugged into a telephone base unit, the accessory may not operate because it has not yet been optimally configured to electronically communicate with the telephone base unit. A Central Office dialtone is applied by the telephone base unit to two of the lines of the jack 202. Under control of the digital MCU 100, the addressable latch 1 manipulates the crosspoint array 2 and the shunt select

array 3 by sequentially coupling pairs of line input ports until a CO dialtone is sensed by the digital MCU 100 in the receive channel. This information is then latched for further analysis by the digital MCU 100.

(page 13, lines 10-27).

Furthermore, the instant patent application discloses that once the receive lines are determined, the transmit lines are determined. Based upon the selected receive lines, certain transmit line configurations are highly probable and are prioritized by algorithms. (page 15, lines 24-27). Thus, the language of “a switch matrix, settable to any of a plurality of switch configurations” in Claim 41 is supported by the written specification including the drawings of the applicant’s patent application.

2. Second claim limitation at issue

The second claim limitation in Claim 41 disputed in the Office Action is “...a control logic, coupled to the switch matrix, that automatically determines which of the plurality of signal lines from the handset port comprise the handset port receive path, determines a preferred switch configuration from among a plurality of switch configurations based upon which of the plurality of signal lines from the handset port comprise the handset port receive path, and sets the switch matrix to the preferred switch configuration, the preferred switch configuration coupling the handset port receive path to the headset receive path.” The rejection was based on the following analysis in the Office Action:

U.S. Patent No. 5,729,603 discloses that control logic test each of the six configurations is tested with a test signal, typically a dial tone and the result is measured via the signal level detector to determine the preferred configuration. Each of the six combinations are tested sequentially and the result is compared to the previous result and the best result is used as the combination. Conversely the applicant’s specification does not disclose the above process to determine the appropriate configuration. Therefore claim 41 fails to meet the requirement of MPEP 2307.02.

Applicant respectfully traverses. The Office Action incorrectly interprets the claim limitation based on the specification of copied patent. However, **there is no ambiguity** in the limitation cited above to warrant such an interpretation of the claim based on the specification of U.S. Patent No. 5,729,603. MPEP 2301.01(D); see also Spina, 958 F.2d 856. Terms in claims should be read using their ordinary meaning, unless there is an express intent to impart a novel

meaning to claim terms. York Prods., Inc. v. Cent. Tractor Farm & Family Ctr., 99 F.3d 1568, 1572, 40 USPQ2d 1619, 1622 (Fed. Cir. 1996). As there is no express intent to impart a novel meaning to claim 41, terms should be read using their ordinary meaning.

Applicant respectfully submits that instead of looking at the specification of U.S. Patent No. 5,729,603, one must look at the specification of the applicant's disclosure. In determining whether a copier of a patentee's patent has a right to make a claim corresponding to a count for interference purposes, the only inquiry is whether a copier's disclosure contains, in accordance with the principles of patent law, support for material limitations of the claim as presented in the patentee's patent. Martin v. Mayer, 823 F.2d 500, 504 (Fed. Cir. 1987)(emphasis added)(superseded on other grounds as explained in Kubota v. Shibuya, 999 F.2d 517, 521 (Fed. Cir. 1993)). By using the ordinary meaning of the terms found in the claim limitation, one skilled in the art would recognize that the applicant had possession of the time of the claimed subject matter.

Notably, under control of the digital MCU 100 (Fig. 7), the addressable latch 1 (Fig. 8) manipulates the switch array 2 by sequentially coupling pairs of line input ports until a CO dialtone is sensed by the digital MCU 100 in the receive channel. (page 13, lines 19-27). Specifically, the present specification states:

The digital MCU 100 is able to address and manipulate the 32 bit addressable latch 1, thereby controlling the 4x4 crosspoint switch array 2 and 100 ohm resistor shunt array 3, within the analog integrated circuit 200. The crosspoint switch array 2 has four input ports which are directly coupled to a four line telephone base unit jack 202 through the array 3, as illustrated by the lines 1-4. The 100 ohm resistor shunt array 3 contains six switchable shunt resistors, is configured in parallel with the crosspoint switch array 2 input ports, and is capable of providing a 100 ohm shunt resistance between any of the 4 line inputs.

When a telephone accessory including the interface system of the present invention is first plugged into a telephone base unit, the accessory may not operate because it has not yet been optimally configured to electronically communicate with the telephone base unit. A Central Office dialtone is applied by the telephone base unit to two of the lines of the jack 202. **Under control of the digital MCU 100, the addressable latch 1 manipulates the crosspoint array 2 and the shunt select array 3 by sequentially coupling pairs of line input ports until a CO dialtone is sensed by the digital MCU 100 in the receive channel. This information is then latched for further analysis by the digital MCU 100.**

(page 13, lines 10-27) (emphasis added). The specification further reads:

The digital MCU 100 will begin manipulating the crosspoint switch array by sequentially coupling pairs of the transmit output ports starting with the most probable pairs defined in the system algorithms. A description, which illustrates the system's switching algorithms, is shown in detail in Figures 4 and 5. The 1 KHz transmit calibration signal is therefore applied to the telephone base unit via the jack lines 202 until the 1 KHz is sensed by the digital MCU 100 at the receive level reference output RX LEVEL REF. When the digital MCU 100 senses the 1 KHz signal it will have successfully located the appropriate transmit lines and will latch the information and begin the transmit output step attenuator TX-5 adjustment.

(page 17, lines 5-14). The patent application further states:

A block diagram of the 4x4 crosspoint switch array 2 and the 100 ohm shunt resistor array 3 is illustrated in Figure 9. The crosspoint switch array consists of a 4x4 matrix of analog switches designed to connect lines 1-4 of the 4 wire phone port 202 to the two transmit and two receive channels in any order and polarity. It is under the control of the digital MCU 100, through the bit addressable latch 1, that the appropriate transmit and receive lines are determined, as described above.

(page 18, lines 20-25) The above descriptions confirm that a digital MCU ("control logic"), coupled to a switch array ("switch matrix"), automatically determines which of the plurality of receive or transmit lines ("signal lines") from the handset port interface comprise the receive path, determines an appropriate switch configuration from among a plurality of switch configurations based upon which of the plurality of lines from the handset port interface comprise the receive path, and sets the switch array ("switch matrix") to the appropriate switch configuration, the appropriate switch configuration coupling the handset port receive path to a headset receive path or other accessory configured to work with the base unit.

Finally, within the Office Action, it is incorrectly stated that the present patent application must disclose a testing process of six switch configurations. As previously described in the last section, a "plurality of switch configurations" means "more than one switch configuration" and should not be limited to six configurations or any other number greater than one. Applicant submits that based on the descriptions noted above and based on the ordinary meaning found in the terms, one of ordinary skill in the art would recognize that the applicant had possession of the claim limitation, ". . . a control logic, coupled to the switch matrix, that automatically determines which of the plurality of signal lines from the handset port comprise the

handset port receive path, determines a preferred switch configuration from among a plurality of switch configurations based upon which of the plurality of signal lines from the handset port comprise the handset port receive path, and sets the switch matrix to the preferred switch configuration, the preferred switch configuration coupling the handset port receive path to the headset receive path” in Claim 41.

Since Claim 41 is unambiguous and also fully supported and described in the specification, it overcomes the § 112, first paragraph rejection. Therefore, the limitations found in Claims 56, 57, and 63, which disclose the same limitations as in Claim 41, are also fully supported and overcome the § 112, first paragraph rejection. Applicant respectfully submits that claims 41-58 and 63 are allowable.

B. Case Law Cited Does Not Stand for the Proposition Claimed in the Office Action

Within the Office Action, Rowe v. Dror, 42 USPQ2d 1550 (Fed. Cir. 1550) is cited for the proposition that the “rule that copied claim is interpreted in light of its originating disclosure applies in context of issue of whether applicant is eligible to copy patentee’s claim” (emphasis in original). Rowe in fact refers to In re Spina, 975 F.2d 854, 24 USPQ 2d 1142 (Fed. Cir. 1992), which has been previously discussed in this Response. Spina states:

When interpretation is required of a claim that is copied for interference purposes, the copied claim is viewed in the context of the patent from which it was copied. DeGeorge v. Bernier, 768 F.2d 1318, 1322, 226 USPQ 758, 761 (Fed. Cir. 1985) (**if claim language is ambiguous** “resort must be had to the specification of the patent from which the copied claim came”).

Spina, 975 F.2d at 856 (emphasis added). Thus, Rowe simply echoes the rule regarding claim interpretation found in Spina *which only applies when ambiguity of claim language exists*. Because no ambiguity exists in the two claim limitations of Claim 41 cited in the Office Action (or any other limitation), the copied claim (Claim 41) should not be viewed in the context of the patent from which it was copied; rather, one should look only to the copier’s disclosure (in this case, to the applicant’s disclosure) for support of material claim limitations. Martin v. Mayer, 823 F.2d 500, 504 (Fed. Cir. 1987)(superseded on other grounds as explained in Kubota v. Shibuya, 999 F.2d 517, 521 (Fed. Cir. 1993)).

C. Applicant's Application Discloses Same Patentable Invention Prior to U.S. Patent No. 5,729,603

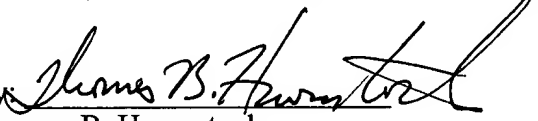
As stated previously, the applicant respectfully submits that the present application supports Claim 41-58 and 63 pursuant to the written description requirement of 35 U.S.C. § 112, first paragraph. Also, the applicant notes that the application has an earlier effective filing date than that of U.S. Patent No. 5,729,603, and therefore discloses the same patentable invention prior to the disclosure of U.S. Patent No. 5,729,603. The applicant's application claims priority of Serial No. 08/625,398, filed March 27, 1996. Therefore the effective filing date of the applicant's application is March 27, 1996. In contrast, U.S. Patent No. 5,729,603 identifies September 30, 1996 as its filing date and is thus six months later.

D. Conclusion

For the reasons given above, the Applicant respectfully submits that the Claims 41-58 and 63 are in a condition for allowance, and an interference should be initiated between the present application and U.S. Patent No. 5,729,603. Should the Examiner have any questions or comments, the Examiner is encouraged to call the undersigned at (408) 530-9700 to discuss the same so that any outstanding issues can be expeditiously resolved.

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Respectfully submitted,
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